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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,658	01/24/2002	Hiromi Nambu	218360US0	9726

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EXAMINER

FUBARA, BLESSING M

ART UNIT PAPER NUMBER

1618

DATE MAILED: 06/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/053,658

Applicant(s)

HIROMI NAMBU

Examiner

Blessing M. Fubara

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5, 7, 8, 10-22 and new claims 29-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5, 7, 8, 10-22 and new claims 29-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Examiner acknowledges receipt of request reconsideration, amendment and remarks, all filed 4/03/06. Claims 23-28 are cancelled. Claim 1 is amended. New claims 29-36 are added. Claims 1, 3-5, 7, 8, 10-22 and 29-36 are pending.

An error is detected in the number of claims rejected in the last officer and this action is made non-final to address the typographical error.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3-5, 7, 8 and 10-22 and 29-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hori et al. (US 4,830,633) in view of Katsuhiko et al. (JP 62103010, English abstract) or Toshiyuki et al. (JP 62230711, English abstract) or Masayuki et al. (JP 11012123, English abstract and computer translated document) or Masaru et al. (JP 11225819, English abstract and computer translated document).

Hori discloses depilatory composition comprising film forming polymer, depilatory medicine and additives such as alkali agent, hair swelling accelerating agent, a filler, perfume and coloring agent (column 2, lines 3-10). The film forming polymer is selected from the group of polyvinylpyrrolidone, polyacrylamide, polyacrylic acid and salts thereof, polyvinyl alcohol,

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carboxymethyl cellulose, methyl cellulose, hydroxyethyl cellulose, hydroxypropyl cellulose, gelatin, alginic acid, alginic acid salts, polyethylene glycol, gum arabic, acrylic esters and polyvinyl methyl ether in an amount of 1-70 wt%, 3-20 wt% depilatory medicine selected from the group of thioglycolic acid or its salts; water; 0.1-5 wt% alkali agents selected from the group of ammonium salt, metal salt of organic dicarboxylic acid, potassium hydroxide, calcium hydroxide and sodium hydroxide; urea as hair swelling accelerating agent; glycerin; dioctyl phthalate plasticizer; an silicon dioxide or calcium carbonate or clay or kaolin or aluminum hydroxide (column 2, line 11 to column 3 line 55 and examples 1, 2 and 7 and claims 1, 3, 5, 6, and 8-10). The composition has a viscosity of from 0.1 to 1,000 poise at 30 OC (column 2, line 53). The composition is applied to underarm and allowed to stand for 15 minutes (example 7) and 10 minutes (example 9) and 8 minutes (example 10). Since Hori teaches the same amount of cross-linking agent (calcium hydroxide) and same amounts of hydrophilic polymer as in the instant claim, it is inherent that the depilatory composition of the prior art, Hori would have the same equivalents of cross-linking agent to ionic group of the hydrophilic polymer as recited in instant claim 19. The process of instant claim 20 applies the composition to an area that requires depilation and the process disclosed in Hori meets that limitation. Hori further discloses homo- or and copolymers of acrylic acid or methacrylic acid esters in claim 4. Although, Hori defines such homo- and copolymers as water insoluble, the disclosed polymers meet the limitation of poly(meth)acrylic acid derivative as defined on page 8, lines 21-25 of the instant specification.

The instant claims are directed to sheet formulation. Hori does not specifically define the composition as a sheet. However, as admitted by applicants in the remarks, Hori discloses

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that a sheet material made of plastic film or paper, non-woven fabric and cloth having a thickness of about 5 to 100 μm (column 3, lines 50-56), hydrophilic non-woven fabric, foamed sheets (column 4, lines 22-31), (meth)acrylonitrile and maleic anhydride graft (column 4, lines 41-68) can be placed over the film or coated with the film for removing hair without leaving residue. Therefore, Hori suggest the use of a sheet having the composition of the type taught by the instant claims.

Katsuhiro, Toshiyuki, Masayuki and Masaru individually disclose using depilatory sheets containing keratin reducing compound, thioglycolate and the sheet formulation is used to remove unwanted hair.

The composition of Hori is used to remove hair. The composition of Katsuhiro, Toshiyuki, Masayuki and Masaru are each also used to remove hair. Thus according to *in re Kerkhoven*, compositions/formulations known in the art to be used for the same purpose can be combined for use for the same purpose.

“It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose....[T]he idea of combining them flows logically from their having been individually taught in the prior art.” *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the formulation of Hori in the method of Hori to remove hair and be motivated as suggested by the Hori art and to use a sheet to aid in the removal of the film from the site of application. One having ordinary skill in the art would have been motivated to

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combine the teaching of Hori with Katsuhiko, Toshiyuki, Masayuki or Masaru to provide a gel sheet comprising the depilatory composition for hair removal without leaving residue. The idea of combining the references flows logically from *in re Kerkhoven*.

Response to Arguments

Applicants argue that the recitation of 300,000 mPa.s is inventive over the viscosity of 100,00 mPa.s; that Hori does not apply depilatory directly to the body, that the combination of the references is improper and there is no expectation of success that the depilatory gel sheet including the depilatory agent of Hori would be effective for removing hairs from the body.


3. Applicants' arguments filed 4/03/06 have been fully considered but they are not persuasive. The depilatory agent of Hori is applied to the body as admitted by applicants in the remarks; a person of ordinary skill in the art is able to adjust the viscosity of the composition in order to effectively apply the composition. Although, claim 23 was found allowable in the office action of 08/11/2004, it was not found allowable upon further consideration as was rejected in the office action of 2/2/2006; the rejection was described in that office action because polyvinyl alcohol is a film-forming polymer in Hori.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is (571) 272-0594. The examiner can normally be reached on 7 a.m. to 5:30 p.m. (Monday to Thursday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Blessing Fubara
Patent Examiner
Tech. Center 1600